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10/595,865

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Kareemullah Shaik

PT-14-828

8195

60413

7590

01/21/2011

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EXAMINER

SMITH, CHAIM A

ART UNIT

PAPER NUMBER

1782

MAIL DATE

DELIVERY MODE

01/21/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,865	Applicant(s) SHAIK ET AL.	
	Examiner CHAIM SMITH	Art Unit 1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Examiners Remarks

1. The application appears to be a literal translation into English from a foreign language, that is to say, it is unclear what the applicants are disclosing and claiming. The application therefore has been examined to the extent that it could be understood.

Oath/Declaration

2. A new oath or declaration is required because of the reasons given below.

3. The oath submitted 20 October 2007 claims foreign priority. "Under certified copy attached?" both blocks (yes and no) are ticked. It is also noted that no certified copy of a prior foreign application has been received by the Office.

4. Names of Inventors: It would appear that the names of each inventor have been reversed in the oath. That is in the block marked Given Name (first and Middle [if any]) the applicants family name or surname has been placed therein and not the applicants first name whilst the applicant's first name has been placed in the block marked Family Name or Surname. This applies for all applicants.

5. The name of the first inventor is listed as Kareemullah Shaik. The signature does not appear to match the listed name.

6. The name of the second joint inventor is listed as Fathima Shaheen. The signature is for a Fathima Sultana, which is not the name of the listed inventor.

7. In the block marked Mailing Address, the first and second inventors list a mailing address of "33, S.D. Road, Secundrabad" whilst the third inventor's address is listed as "33, S.D. Road".

8. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP § 602.01 and § 602.02.

Specification

9. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required to be submitted. The substitute specification filed must be accompanied by a statement that it contains no new matter.

10. The following guidelines illustrate the preferred layout and content for the specification of a utility application. These guidelines are suggested for the applicant's use. Applicants' attention is further invited to MPEP § 608 and the subsections appended thereto, particularly subsections § 608.01(a) to § 608.01(h).

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

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- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (d) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (e) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

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- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

11. In the “field of invention” numerous words are capitalized in mid sentence which should not be, such as Dairy, Non Dairy, Frozen, Frozen Dessert. These are but a few examples. Applicants are requested to make corrections.

12. There is no “Brief Summary of Invention” as required by 37 CFR 1.173 and MPEP § 608.01. Whilst applicants disclose many “objectives of the invention” such as:

- a. To convert the already premium product in a power product.
- b. To bring various ice creams, dessert soft serves and the like under one portfolio giving more revenue and low cost production.
- c. It acts as a walking parlor.
- d. Another feature of the invention is to have a kiosk concept.

to name a few examples, the examiner is unable to find any disclosed invention, summary or otherwise, which seems to relate to these objectives in the specification.

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13. Regarding the "Description of the Drawings", on page 6 in paragraph 8 applicants begin "according to the attached figures 1" which seems to indicate each figure is to be discussed as should be done. The examiner notes that there are only 14 figures yet 28 "figures" appear to be mentioned. It would appear that the numbers given refer to reference signs, which should properly appear in the "Detailed Description of Invention". Further the reference signs should be mentioned with respect to the particular figure in which they are shown.

14. As disclosed applicants invention appears to be a package for containing ice cream products, a part of said package which can be removed from said ice cream by peeling. The examiner finds no apparent disclosure with respect to an actual method of using said package, such as scooping ice cream from a container, placing said ice cream in said package, and further directing a user or consumer as to how to any method of use of the filled package is to be done.

Claim Rejections - 35 USC § 112

15. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. Claims 1 – 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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17. In general the claims appear to be directed to “The method of packing and presentation of ice-cream, desserts and the likes in the form of scoops” however since no actual steps relating to any method of performing said packing and presentation have actually been disclosed or recited as occurring in the claims one of ordinary skill in the art would not know how to practice applicants’ invention.

18. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. Claims 1 - 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

20. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

21. Claims 1 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

22. In claim 1 no actual packing or presenting steps are recited making it unknown what it is applicants are intending to claim as their invention.

23. Claims 2 – 5 appear to describe a container. No actual steps of placing any type of product, such as ice cream, into said container, removal of said product from the container to another container, and serving or consuming said product are recited as occurring making it unknown what applicants are claiming as their invention.

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24. Claims 6 and 7 appear to relate to a product shape. There is no positive recitation of what said shape would actually be or how it would be attained making it unclear to one of ordinary skill in the art what particular shape, if any, would infringe on the claims. Similarly with respect to claims 9 and 10.

25. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. Further since the examiner is unable to determine what is actually intended to be claimed, claim 8 has not been further examined on the merits.

26. Further regarding claim 1, there is no antecedent basis for the recitation “the method of packaging and presentation”.

27. Regarding claim 2, there is no antecedent basis for the recitation of “the packing”.

28. Regarding claims 3, 4, 7, there is no antecedent basis for the recitation of “the product”. Further it is unclear if “the scoop” of claim 3 is the same as the “scoops” of claim 1.

29. Regarding claim 4, whilst the inner container is claimed to be peelable it is noted that as recited no actual peeling is required to take place.

30. Regarding claim 5, there is no antecedent basis for the recitation “the serving container”.

31. Regarding claim 6, there is no antecedent basis for the recitation “the design”, “the inner shape” or “the inner surface”

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32. Regarding claim 7, it is unknown what is meant by “the shape of the scoops is rested into the actual shapes”. Further there is no antecedent basis for the recitation “the shape of the scoops” or “the actual shapes”.

33. Regarding claim 8, there is no antecedent basis for the recitation “the soft serve”.

34. Regarding claims 9 and 10, there is no antecedent basis for the recitation “the spacer”.

35. Regarding claim 10, it is unknown how the spacer could be inserted in the inner container since it has already been fixed inside the outer container in claim 9.

Claim Rejections - 35 USC § 103

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

38. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

39. Claims 1 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda JP 900256.

40. Regarding claim 1, Maeda discloses a method of packing and presenting ice cream in the form of scoops (semi spherical ice cream) (English abstract). Note that packaging and presenting an ice cream scoops has not been positively claimed as being done.

41. Regarding claim 2, Maeda discloses there is an inner (19) and outer (12A) container (fig. 1 and 2) (machine translation, the name of reference signs)

42. Regarding claim 3, Maeda discloses the inner container holds the product in the form of a scoop (semi spherical ice cream) (English abstract).

43. Regarding claim 4, the inner container can be peeled off to expose the product for consumption (12Aa is separated, machine translation [0020], [0021]), (fig. 1, reference signs 14, grip part, 13 virtual break line). Note that as recited the inner container need not be peeled off of any product, but only be capable of being peeled, which Maeda certainly is capable of doing.

44. Regarding claim 5, the outer container (fig. 1 and 2, reference sign 12A) could obviously be used to serve the ice cream.

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45. Regarding claim 6, ice cream being a semi-plastic material when packaged would obviously conform to the shape of the container provided.

46. Regarding claim 7, if the product would be served in the outer container the shape of the scoop would be the actual shape of the container.

47. Claims 1 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda JP 900256.

48. Claims 1 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda JP 900256 in view of Suzuki JP 3210151.

49. Claims 9 (1 – 5) differ from Maeda in the outer container having a spacer fixed inside the outer container. Suzuki discloses the placement of a spacer (cone 3) (English abstract and fig. 1 and 2) fixed inside an outer container. Suzuki is fixing the spacer inside the outer container to create a space in an ice cream product to assist in said products removal from container which is believed to be applicants' reason for doing so as well. To therefore fix a spacer in the outer container of Maeda would have been an obvious matter of choice.

50. Regarding claim 10, insertion of the spacer into the inner container of Maeda in view of Suzuki would be seen to press the product to give a semi scooped shape.

Conclusion

51. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

52. Depince FR 2 713 208 discloses ice cream enclosed in a cylindrical mould, which is an inner container, and an outer container. The inner container is removed from the ice cream and the ice cream consumed.

53. Oda JP 60141239 discloses that methods of packaging ice cream scoops are notoriously conventional.

54. Scholler Lebensmittel EP 0 216 107 discloses it was conventional to package ice cream scoops which could be presented.

55. Voûte EP 0 278 576 discloses the packaging of an ice confection as a scoop in a container from which the confection could be consumed.

56. Krein US 2,104,805 discloses the packaging and presentation of portions of ice cream.

57. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAIM SMITH whose telephone number is (571)270-7369. The examiner can normally be reached on Monday-Thursday 7:30-5:00.

58. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

59. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. S./

Chaim Smith

Examiner, Art Unit 1782

16 January 2011

/Rena L. Dye/

Supervisory Patent Examiner, Art Unit 1782